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Paper No. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK H. MILLER, BRUCE E. WIGTON
and KENNETH LONNGREN

Appeal No. 2000-1914
Application No. 08/718,643

OH BRIEF¹

MAILED

JAN 29 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before COHEN, FRANKFORT, and NASE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

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This is an appeal from the final rejection of claims 1 through 7, 11 through 16, 19, 21, 22, 26 through 32, 34 through 40, and 48 through 57. Claims 8 through 10 stand allowed. Claim 46 stands withdrawn from consideration by the examiner pursuant

¹ After a review of the appeal, this panel of the Board, in accordance with 37 CFR 1.194(c), determined that the oral hearing set for January 25, 2001 was not necessary since the examiner's three rejections under 35 U.S.C. § 103(a) could not be sustained. Counsel for appellants was so notified by Programs and Resources Administrator Craig Feinberg on January 22, 2001.

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to a requirement for restriction. Claims 17, 18, 20, 23 through 25, and 47 are objected to as being dependent upon a rejected base claim but would be allowable according to the examiner if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 33 and 41 through 45 have been canceled. These claims constitute all of the claims in the application.

Appellants' invention pertains to a device for attracting insects, an insect trapping device, a method of urging insects into a device, and a method of disabling insects. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 28, 31, and 40, copies of which appear in the APPENDIX to the main brief (Paper No. 28).

As evidence of obviousness, the examiner has applied the documents listed below:

Deyoreo et al (Deyoreo)	5,301,458	Apr. 12, 1994
Bible	5,329,725	Jul. 19, 1994
Butler et al (Butler)	5,417,009	May 23, 1995

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The following rejections are before us for review.²

Claims 1 through 7, 11 through 16, 19, 21, 22, 27, 31, 32, 34 through 36, 40, 48, 49,³ and 55 through 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Deyoreo.

Claims 26 and 37 through 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deyoreo, as applied to claims 11 and 31 above, further in view of Butler.

Claims 28 through 30 and 50 through 54 stand rejected under 35 U.S.C. § 103 as being unpatentable over Deyoreo, as applied to claims 1, 11, 31, 40, and 48 above, further in view of Bible.

The full text of the examiner's rejections and response to the argument presented by appellants appears in the final rejection and answer (Paper Nos. 11 and 30), while the complete

² A final rejection of claims 50, 51, and 53 under 35 U.S.C. § 112, second paragraph, was overcome, as set forth in the advisory action of March 4, 1999 (Paper No. 18).

³ Claim 49 has been added to the statement of the rejection, since in the body of the rejection on page 2 of the final rejection (Paper no. 11) claim 49 is specified.

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statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 28 and 33).

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,⁴ and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

This panel of the board reverses each of the examiner's rejections of appellants' claims under 35 U.S.C. § 103(a). Our reasoning appears below.

⁴ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

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At the outset, it is important to appreciate that each of appellants' respective independent device and method claims 1, 11, 28, 31, 40, and 48 requires, inter alia, a flow of "an insect attractant".

The primary reference relied upon by the examiner in each of the obviousness rejections on appeal is the Deyoreo patent. A reading of the Deyoreo document makes it abundantly clear to us that the patentee's focus (column 1, lines 6 through 19 and column 2, lines 32 through 40) was upon an insect killer or attracting device which employs a light source to attract insects.

Based upon the overall teaching of Deyoreo alone, as relied upon by the examiner in the rejection of independent claims 1, 11, 31, 40 and 48, it is apparent to us that only impermissible hindsight and reliance upon appellants' own teaching would have enabled one having ordinary skill in the art to so alter and reconfigure the insect killer of the applied patent to yield the now claimed invention with its particular feature of a flow of insect attractant. Turning now to the other rejections, inclusive of the rejection of remaining independent claim 28, the

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examiner relies upon features found in the respective teachings of Butler (carbon dioxide as an attractant) and Bible (mesh screen). Notwithstanding the particular features relied upon by the examiner in these additional references, it is quite apparent to us that the deficiency of the Deyoreo reference is not overcome thereby. Since the evidence proffered by the examiner does not support a conclusion of obviousness relative to appellants' claims, each of the rejections on appeal must be reversed.

REMAND TO THE EXAMINER

1. On page 1 of appellants' application, U.S. Patents to Plunkett (3,196,577) and Cody (5,157,090, sic 5,167,090) are specified. The Plunkett (Fig. 2) and Cody (Fig. 3) patents each show devices which provide an outflow of air and insect attractant wherein an inflow appears to be directed near an upper edge of the outflow outside the device. The examiner should assess these documents in particular relative to independent claim 48 (and its dependent claims) under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

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2. As acknowledged by appellants in the main brief (page 2), the examiner denied entry of a declaration (letter by Daniel Kline, Ph.D.) and an exhibit which details sales information. However, appellants request reconsideration of the refusal to consider the declaration and also point out that an amendment accompanies the appeal brief providing an updated sales report and a declaration (Raymond Iannetta). The examiner should address the noted request and amendment, each of which were not mentioned in the answer.

As a final point, we note that should the examiner reject claims under 35 U.S.C. § 103, with evidence of nonobviousness (secondary considerations) entered into the application, the examiner must assess the evidence of obviousness with the evidence of nonobviousness; See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

In summary, this panel of the board has:

reversed the rejection of claims 1 through 7, 11 through 16, 19, 21, 22, 27, 31, 32, 34 through 36, 40, 48, 49, and 55 through 57 under 35 U.S.C. § 103(a) as being unpatentable over Deyoreo;

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reversed the rejection of claims 26 and 37 through 39 under
35 U.S.C. § 103 as being unpatentable over Deyoreo and Butler;
and

reversed the rejection of claims 28 through 30 and 50
through 54 under 35 U.S.C. § 103 as being unpatentable over
Deyoreo and Bible.

We have also remanded the application to the examiner for
consideration of the matters addressed above.

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